

Appln. No. 10/618,249  
Amendment Response to Office Action dated September 27, 2006  
Attorney Docket No. 47004.000251  
January 29, 2007

### **REMARKS**

Claims 1 and 35-59 are pending in this application. Claims 1 and 35 have been amended. No new matter has been added by way of this amendment. Claims 60-67 are new.

Claims 1 and 35-59 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. *See* Office Action at p. 2. Claims 1 and 35-59 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,014,645 to Cunningham ("Cunningham") in view of "VISA, MBNA and De La Rue Launch Multi-Function Smart Card Program," De La Rue PLC 7/06/1998 ("De La Rue"). *See* Office Action at pp. 3-13. Applicants traverse these rejections as set forth below.

#### **I. Rejections Under 35 U.S.C. § 112, First Paragraph – Written Description Requirement.**

Claims 1 and 35-59 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. *See* Office Action at p. 2. Claims 1 and 35 have been amended and Applicants respectfully request that these rejections be withdrawn.

#### **II. Rejections Under 35 U.S.C. § 112, Second Paragraph – Indefiniteness.**

Claim 1 was previously rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which application regards as the invention. *See* Final Rejection at p. 2-3. Applicants previously amended the Claim 1 to more clearly recite that the secondary feature of the card is "optional". This rejection has not been maintained and therefore Applicants thank the Examiner for withdrawing this rejection.

#### **III. Rejections Under 35 U.S.C. § 103(a) – Obviousness.**

Claims 1 and 35-59 have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,014,645 to Cunningham ("Cunningham") in view of "VISA, MBNA and De La Rue Launch Multi-Function Smart Card Program," De La Rue PLC 7/06/1998 ("De La Rue"). *See* Office Action at pp. 3-13.

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Claims 1 and 35 have been amended to recite a method for activating a multi-value card having at least one feature and at least one optional secondary feature (claim 1) or "different features" (claim 35) and to include the limitation of "wherein prior to the activation of the primary feature or any secondary features the multi-value card contains or is associated with information related to the primary feature and the one or more optional secondary features" (claim 1) or "wherein prior to the activation of any features the multi-value card contains or is associated with information related to the different features" (claim 35).

Applicants respectfully submit that neither Cunningham, nor De La Rue, alone or in combination, disclose these limitations of claims 1 and 35 and, therefore, these references do not support a *prima facie* case of obviousness.

De La Rue discloses a program that combines credit, stored value, and loyalty functions on a single smart card, and compares its technology of a card having an embedded microchip to former technology including magnetic stripe cards. *See* De La Rue at p.1, para. 1. De La Rue does not disclose a multi-value card having multiple features that is activated as claimed in independent claims 1 and 35, wherein prior to the activation of the different features, the multi-value card contains or is associated with information related to the different features.

Cunningham discloses a system for presenting financial card offers to potential customers. *See* Abstract. *See also* Office Action at p. 15 (the Examiner notes that Cunningham "is concerned with locating offers for financial cards for customers.") Cunningham does *not* disclose, however, any system or method used by a financial institution that may offer a customer a financial card to activate that card.

The system of Cunningham "allows users to peruse and accept financial card offers from financial institutions interested in locating customers who meet specific selection criteria." Col. 2, lines 12-15. The user is prompted to provide "pertinent information," and additional information may be obtained using the information provided by the user. Col. 2, lines 15-18. The user is assigned a "financial risk rating" or "grade/score" which can be used to identify financial card offers. Col. 2, lines 18-23. The user can accept an offer, and the user is sent a financial card in accordance with the offer. Col. 2, lines 24-29.

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The Examiner states that Cunningham "discloses a method using a computer system for a real time customer activation of a value card having a primary feature wherein the system automatically processes a customer's activation of the value card (Column 2, lines 9-29) . . ." Office Action at p. 3. Applicants respectfully disagree that this cited section, or any section, of Cunningham discloses a computer system for customer activation of a value card having a primary feature wherein the system automatically processes a customer's activation of the value card. Rather, this section as previously discussed discloses a system for users to "peruse and accept financial card offers from financial institutions." Col. 2, lines 12-13.

The further cited sections of Cunningham similarly do not disclose such a system for activation of a value card. Column 2, lines 15-19, cited on p. 3 of the Office Action, discloses the following in its entirety:

The present invention - which may be accessed via the World Wide Web - prompts a user for pertinent information. Additional credit history data may be obtained using the personal and financial information provided by the user.

This section discloses only that a user inputs "pertinent information" which is used to obtain further information such as a credit history. See col. 2, lines 16-18. There is *no* disclosure in this section of receiving a customer's request to activate a multi-value card into a system.

Column 3, lines 23-26 discloses the following in its entirety:

Because security is a significant issue for online financial information systems, a Firewall 20 is established between the Router 18 and the Web Server 22. Transactions may then occur in a secure environment.

This section discloses only that a firewall is established between a Router 18 and the Web Server 22 to provide a secure environment for transactions. There is *no* disclosure in this section of Cunningham of "providing at least one or more safety features to determine whether said customer is the person whose name is printed on said transaction card."

Column 4, line 65 - column 5, line 5 discloses the following in its entirety:

The applicant may peruse, via the computer display, the "federal box" and other details of each of the offers to find the one that is most attractive (e.g., has the most favorable terms). If the

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applicant accepts one of the offers, the application data for the applicant is forwarded to the financial institution that made the accepted offer. The financial institution then processes the application and makes arrangements to send the financial card to the applicant.

This section discloses only that the applicant can peruse details of offers of financial cards, and that application data is forwarded to the financial institution if the applicant accepts one of the offers. There is *no* disclosure in this section of activating the transaction card by confirming the customer's desire to activate the primary value card use that is automatically processed by the system. There is no disclosure at all in this section of how the activation of the financial card is performed - rather, this section states only that the financial institution processes the application and makes arrangements to send the financial card to the applicant.

Further, neither Cunningham nor De La Rue disclose the limitation in claims 1 and 35 as amended that wherein prior to the activation of any features the multi-value card contains or is associated with information related to the different features.

Neither Cunningham or De La Rue disclose the claimed method of activation of a multi-value card that is automatically processed by a system, wherein prior to the activation of any features the multi-value card contains or is associated with information related to the different features. Rather, a combination of Cunningham and De La Rue discloses only the smart card of De La Rue that combines credit, stored value, and loyalty functions that may be offered to an applicant under certain terms based on that applicant's "financial risk rating," as determined from "pertinent information" that the applicant enters into the system of Cunningham for consideration of an offer of a financial card by financial institutions. Accordingly, Cunningham and De La Rue in combination do not support a *prima facie* case of obviousness because they do not disclose each and every limitation of claims 1 and 35. Applicants respectfully submit that these rejections should be withdrawn.

Further, since claims 36-59 are dependent from claim 35, the rejections under 35 U.S.C. § 103(a) over Cunningham and De La Rue should be withdrawn over these additional claims for

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the same reasons. For the foregoing reason, Applicants respectfully request that the rejections be withdrawn.

#### IV. New claims 60-67.

New claims 60-67 have been added. Claims 60-63 are dependent from claim 1, and claims 64-67 are dependent from claim 35. Since the cited references of De La Rue and Cunningham do not disclose each and every limitation of claims 1 and 35, Applicants respectfully submit that claims 60-67 are also allowable based on their dependency on claim 1 and 35.

#### V. Response to Examiner's Arguments.

The Examiner states that in De La Rue "the smart chip technology is described as an emerging market technology (page 1) . . . [f]urther mentioned as 'traditional' methods include magnetic stripe bank cards (page 2) . . . [t]herefore the traditional magnetic bank cards are disclosed as well known, but is disclosed as being the old and potentially inferior technology to the emerging smart chip cards, which serve the same purpose." Office Action at p. 16. Applicants respectfully disagree with this conclusion that traditional magnetic bank cards are "serve the same purpose" as emerging smart chip cards. Rather, Applicants note that De La Rue *expressly notes* that placement of "the functions of several traditional bankcards onto a single microchip" are accomplished by the "emerging technology" of the integrated circuit chip, which increases the "value of and demand for smart cards" due to these "value-added services" over traditional magnetic-stripe cards. *See* De La Rue at p. 1-2. De La Rue discloses that it is the integrated circuit chip card that "increase[s] the value of and demand for smart cards" over "traditional magnetic-stripe bankcards." *Id.* Moreover, De La Rue discloses a card that combines "different payment methods onto a single card platform...*by using the power of the integrated circuit chip* to provide more flexible rewards programs, which afford greater benefit to cardholders, affinity groups, merchants, and card issuers." *See* De La Rue at p. 1, last paragraph (emphasis added). In other words, the benefits of De La Rue's multi-function card are achieved "by using the power" of smart card technology and not from a magnetic stripe or similar traditional technologies. Therefore, De La Rue *teaches away* from the claimed invention

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because smart card technology, and not a traditional method, such as magnetic stripes, provides the multi-function benefits to cardholders and merchants in De La Rue's disclosure.

Applicants respectfully submit that De La Rue does *not* teach microchip technology as a preferred alternative to traditional magnetic stripe bankcards. Rather, De La Rue makes clear that the multi-functions of the disclosed card were *enabled* by the development of microchip technology, as previously discussed. Applicants respectfully submit that there is no teaching in De La Rue of a magnetic-stripe bankcard having the multi-functions of its smart card as an alternative embodiment.

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### CONCLUSION

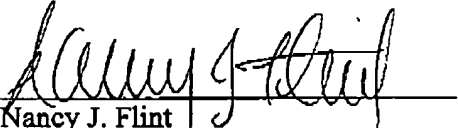
Applicants respectfully submit that claims 1 and 35-67 are in condition for allowance and earnestly solicit the same in view of the amendments and remarks made herein. This Amendment and Response has been filed within four months of the mailing date of the Office Action of September 27, 2006, and Applicants hereby authorize the Commissioner to charge the fee of \$120.00 for a one month extension of time to the undersigned's Deposit Account No. 50-0206. If any variance from these fees are found, please credit or charge the difference to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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